

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANS-DETLEF ARNTZ,
KLAUS BRECHT, BERNHARD JOHN,
PETER SEIFERT and MICHAEL SCHNEIDER

MAILED

MAR 31 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2005-0870
Application 10/018,177 ¹

ON BRIEF

Before PAK, WALTZ and KRATZ, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 22, which are all the claims pending in the above-identified application.

Claims 11 and 12 are representative of the subject matter on appeal and a copy of these claims is appended to this decision.

¹ Application for patent filed December 12, 2001.

Appeal No. 2005-0870
Application No. 10/018,177

Claims 12, 13 and 16 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking written descriptive support for the subject matter presently claimed. Claims 11, 15, 17 through 19 and 21 stand rejected under 35 U.S.C. § 102(b) as anticipated by the disclosure of U.S. Patent No. 4,124,572 issued to Mao on November 7, 1978 (hereinafter referred to as "Mao"). Claims 14, 20 and 22 stand rejected under 35 U.S.C. § 103 as unpatentable over the disclosure of Mao.

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the examiner and the appellants in support of their respective positions. This review has led us to conclude that the examiner's rejections are not well founded. Accordingly, we will not sustain the examiner's rejections for essentially those reasons set forth in the Brief and Reply Brief. We add the following primarily for emphasis.

We turn first to the rejection of claims 12, 13 and 16 under 35 U.S.C. 112, first paragraph, as being based upon a disclosure which fails to satisfy the written description requirement of that paragraph. According to *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983):

Appeal No. 2005-0870
Application No. 10/018,177

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed **reasonably conveys** to the artisan that the inventor had possession at that time of the later claimed subject matter, **rather than the presence or absence of literal support** in the specification for the claimed language. The content of the drawings may also be considered in determining compliance with the written description requirement. (Emphasis added).

Precisely how close the original description must come to the claimed subject matter in order to comply with the written description requirement must be determined on a case-by-case basis. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561-63, 19 USPQ2d 1111, 1115-17 (Fed. Cir. 1991).

Here, the examiner contends that the claimed polyester polyol compositions having components "totaling 100 mol percent" have no descriptive support in the specification as originally filed. See the Answer, page 3. However, the specification, as originally filed, discloses generic polyester polyol compositions having the claimed components, with each of the three preferred specific polyester polyol compositions within the generic compositions having components totaling 100 mol%. See the Specification, pages 5 and 6. Thus, from our perspective, the

appellants' original disclosure as a whole would have reasonably conveyed to a person having ordinary skill in the art that the inventors had possession of the generic polyester polyol compositions having the claimed components totaling 100 mol percent. Accordingly, we reverse the examiner's decision rejecting claims 12, 13 and 16 under Section 112, first paragraph.

We turn next to the examiner's rejection of claims 11, 15, 17 through 19 and 21 stand rejected under 35 U.S.C. § 102(b) as anticipated by the disclosure of Mao. Under Section 102(b), anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. *See In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Here, the examiner relies on the disclosure of Mao to teach the claimed process for producing a (polyurea)polyurethane having oil and petroleum resistance properties. The examiner, however, does not indicate where Mao teaches a step for reacting the

claimed specific polyether polyol component with a polyester polyol component in a particular proportion. See the Answer, pages 3 and 4. The examiner simply takes the position that Mao teaches "equivalent reactants in overlapping ratios..." See the Answer, page 4. The examiner's own position indicates that Mao does not teach reactants and reactant proportions identical to those claimed. Thus, we concur with the appellants that the examiner has not demonstrated that Mao discloses, either expressly or under the principles of inherency, each and every element of the claimed process. Accordingly, we are constrained to reverse the examiner's decision rejecting claims 11, 15, 17 through 19 and 21 under Section 102(b).

We turn next to the examiner's rejection of claims 14, 20 and 22 under 35 U.S.C. § 103 as unpatentable over the disclosure of Mao. Under Section 103, the test for obviousness is what the teachings of the applied prior art would have suggested to those of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). The obviousness of a claimed invention cannot be established absent some suggestion or

Appeal No. 2005-0870
Application No. 10/018,177

incentive to arrive at the claimed features. *See ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Here, the examiner again relies on the disclosure of Mao to teach and/or suggest the claimed process. The examiner, however, does not indicate where Mao teaches or suggests the employment of the claimed specific polyether polyol component in Mao's process. Rather than explaining why it would have been *prima facie* obvious to employ the claimed specific polyether polyol component, the examiner simply concludes that Mao teaches "equivalent reactants" as those claimed. See the examiner's Answer, pages 4-5. Since the examiner has not referred to any factual basis, much less provided a reason, for employing the claimed specific polyether polyol component, we are again constrained to reverse the examiner's decision rejecting claims 14, 20 and 22 under 35 U.S.C. § 103.

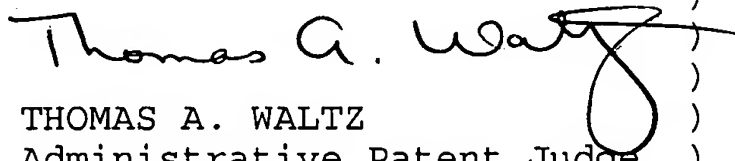
Appeal No. 2005-0870
Application No. 10/018,177

In view of the foregoing, the decision of the examiner is reversed.

REVERSED



CHUNG K. PAK)
Administrative Patent Judge)



THOMAS A. WALTZ)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES



PETER F. KRATZ)
Administrative Patent Judge)

CKP:vsh

Appeal No. 2005-0870
Application No. 10/018,177

BAYER MATERIAL SCIENCE, LLC
100 BAYER ROAD
PITTSBURGH, PA 15205

APPENDIX
Claims 11 & 12

11. A process for the production of a (polyurea)polyurethane which is oil and petroleum resistant as determined in accordance with DIN EN 344 comprising reacting a mixture comprising

- A1) a polyether polyol component having a number average molecular weight of from 1000 to 8000 g/mol and a hydroxyl functionality of 2.0 or is substantially a mixture with an average hydroxyl functionality of 2.02 to 2.95 comprising
 - a) at least one polyether diol with a hydroxyl value in the range of 10 to 115 prepared by propoxylation of a difunctional starter compound and subsequent ethoxylation at a ratio by weight of propylene oxide to ethylene oxide of 60:40 to 85:15 and
 - b) at least one polyether triol with a hydroxyl value in the range of 12 to 56 prepared by propoxylation of a trifunctional starter compound and subsequent ethoxylation at a ratio by weight of propylene oxide to ethylene oxide of 60:40 to 85:15,
- A2) from 3 to 30 wt.% based on total weight of components A1) and A2), of a polyester polyol component having a number average molecular weight of from 1000 to 6000 g/mol prepared by polycondensation of a) an organic polycarboxylic acid and/or a derivative thereof and b) a polyhydric alcohol,

- B) a polyisocyanate component,
- C) a chain extending agent,
and optionally,
- D) a blowing agent and/or
- E) an additive
at an isocyanate index of from 70 to 130.

12. The process of Claim 11 in which the polyester polyol component comprises

- (1) from 20 to 50 mol%, based on mols of polyester polyol, of units derived from adipic acid,
- (2) from 0-20 mol%, based on mols of polyester polyol, of units derived from glutaric acid,
- (3) from 0 to 10 mol%, based on mols of polyester polyol, of units derived from succinic acid,
- (4) from 10 to 30 mol%, based on mols of polyester polyol, of units derived [from] neopentyl glycol,
- (5) from 10-40 mol%, based on mols of polyester polyol, of units derived from hexanediol,
- (6) from 0-15 mol%, based on mols of polyester polyol, of units derived from ethanediol, and
- (7) from 10-20 mol%, based on mols of polyester polyol, of units derived from butanediol,

with the sum of (1) through (7) totalling [sic, totaling] 100 mol%.